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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,536	01/12/2001	Carl Teo Balbach	31215.new	1174
7590	01/09/2006		EXAMINER	
R. Kent Roberts Hodgson, Russ, Andrews, Woods & Goodyear LLP One M&T Plaza, Suite 2000 Buffalo, NY 14203-2391			OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	
			DATE MAILED: 01/09/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/759,536	BALBACH, CARL TEO
	<b>Examiner</b>	<b>Art Unit</b>
	Jonathan Ouellette	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 11 October 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3-16,18-30,32-41,43-45 and 47 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-16,18-30,32-41,43-45 and 47 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1, 3-16, 18-30, 32-41, 43-45, and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**
3. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
4. Independent Claims 1, 16, 30, 41, and 44 describe analyzing an electronic source document available on a network of computers to determine a referenced entity identified in the document. However, neither the claims nor the specification describes how the system/method *determines* the “referenced entity” or corresponding identifier in the electronic source document from the remainder of the electronic source document material.
5. The specification further states: “The present invention may examine the context of the article to establish: 1) the points of contact within an entity that the reader or viewer most likely wishes to contact; and 2) entities that are not explicitly referenced in the article or video presentation, but may have substantive bearing on the issues discussed in the article or video presentation. However, neither the claims nor the specification describes how

the system/method *determines* the initial entity or “entities that are not explicitly referenced” from the remainder of the electronic source document material.

6. Finally, the Examiner is not aware of any technology known at the time the invention was made that would enable the system/method (or make obvious) the extrapolation or resolution of detailed entity information (referenced entity, corresponding identifier, points of contact, entities that are not explicitly references) from a textual-based or audible-based source document, as described in the claimed invention.

#### *Response to Arguments*

7. Applicant's arguments filed 10/11/2005, with respect to Claims 1, 3-16, 18-30, 32-41, 43-45, and 47, have been fully considered, but are not persuasive. The rejection will remain as FINAL based on previous arguments.
8. The Applicant has made the argument that it would have been obvious to one of ordinary skill in the art at the time the invention was made to know how to cause a computer to analyze an electronic source document to determine a referenced entity identified in the document. The Applicant also sited the following example from the specification: “the invention scan a document, and matches it against a database of known individuals and organizations.” (Pg.4, L1-3)
9. However, the specification fails to teach how a system would scan an electronic source document available on a network, without downloading the document onto the user's system and identifying types of reference entity information the system should scan for (letters, words, numbers, names, addresses, author, editor, publisher, etc.).

10. Furthermore, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to know how to scan every letter/word/number of a *networked document* in order to determine an entity, and compare said entity to a stored database of entities.
11. The Applicant has further made the argument that the Examiner sited prior art (Hedloy) that disclosed analyzing an electronic source document to determine a referenced entity identified in the document.
12. However, after further consideration by the Examiner, Hedloy was removed withdrawn in the previous office action (8/12/2005).
13. Furthermore, Hedloy disclosed the matching of select pieces of information manually entered by the user onto a document with a database of previously stored entity addresses/information.

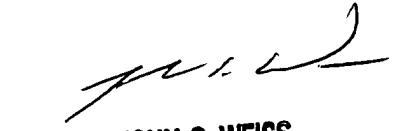
### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.



JO  
December 28, 2005



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600